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	Filing Date	June 27, 2003
	First Named Inventor	Jerry E. Elliot
	Art Unit	3679
	Examiner Name	Aaron M. Dunwoody
Total Number of Pages in This Submission	Attorney Docket Number	10/CIP

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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**  
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Jerry E. Elliott

Serial No: 10/608,290

Filed: June 27, 2003

Title: ADJUSTABLE PIPE REPAIR CLAMP  
INSTALLATION TOOL

Attorney's Docket No.: 10/CIP

)  
) Confirmation No: 8523  
)

) Technology Center: 3679  
)

) Examiner: Aaron M. Dunwoody  
)  
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*Cynthia Ortiz*  
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**APPLICANT'S REPLY BRIEF**

In re applic. of Jerry E. Elliott  
Applic. No. 10/608,290  
Technology Center No. 3679  
Page No. 2

### **I. Status of Claims**

In the final rejection of December 23, 2005, claims 1-40 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 1,445,286 to Bosco in view of U.S. Patent No. 1,619,749 to Murray. In the Examiner's Answer, the rejection based on the combination of Bosco and Murray has been limited to claims 1-3 and 11-40. Thus, claims 4-10 are allowed.

## **II. Grounds of Rejection to Be Reviewed on Appeal**

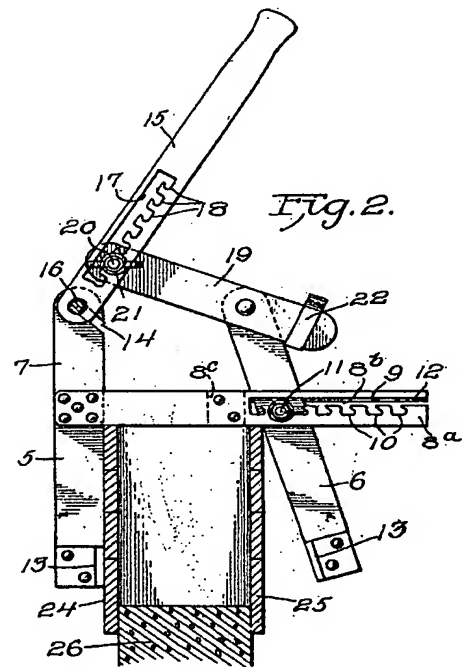
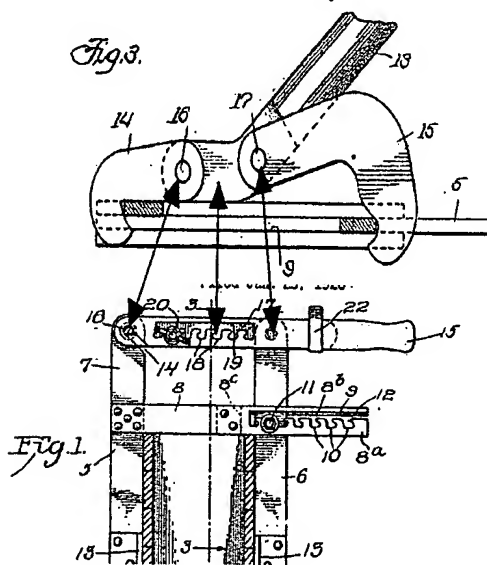
Claims 1-3 and 11-40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bosco in view of Murray. In rejecting the two pending independent claims 1 and 21, the examiner relies upon the patent to Bosco as disclosing a body portion 13 having first and second opposed ends and an intermediate portion disposed therebetween, and an arm 14 having a first end pivotally coupled to the body portion by means of a first pivot pin adjacent the first end thereof, with the arm further including a second opposed end adapted for insertion in an aperture in a first edge flange of a repair clamp. The examiner further relies upon Bosco as disclosing a clasp 15 pivotally coupled to the body portion 13, intermediate the first and second opposed ends thereof by means of a second pivot pin, where the clasp is adapted to engage an outer edge of the repair clamp's second edge flange for drawing the repair clamp's edge flanges together when the body portion undergoes pivoting displacement about the arm and clasp from a first position to a second position for allowing nut and bolt combinations to be tightened for securing the repair clamp to the pipe in a sealed manner. The arm and clasp may then be disengaged and removed from the edge flanges and the apparatus removed from the repair clamp. The examiner concedes that Bosco does not disclose an adjustable coupling means disposed in Bosco's body portion 13.

The examiner relies upon Murray as disclosing an adjustable coupling means in the form of an elongated aperture 17, spaced notches 18 disposed along the length of the elongated aperture, a screw or bolt 20 passing through the aperture 17 and disposed in one of the notches or recesses 18, and a winged nut 21 attached to bolt 20. The examiner presumes that Murray's crosshead 7 can be

equated to Bosco's claw 14 and that the combination of Murray's second jaw member 6 and link lever 19 can be equated to Bosco's claw 15. Relying upon these presumptions, the examiner concludes that it would have been obvious to incorporate the adjustable mechanism of Murray in the body of Bosco to provide a dead lock for the lever when in operation as allegedly taught by Murray. In rejecting independent claim 21, the examiner has merely repeated the recitations of this claim and has not indicated specifically which portions of the two cited references are relied upon as disclosing the claimed structures and the cooperation and interaction of the claimed structures, it being assumed that the examiner is relying upon the same elements as discussed with respect to claim 1.

### III. Argument

The Examiner maintains that the combination of Bosco and Murray establishes a *prima facie* case of obviousness and that these two references, when combined, teach or suggest all of the claimed limitations. Applicant disagrees with this contention and relies, in part, upon the Examiner's use of FIG. 3 in Bosco and FIG. 1 in Murray as discussed in the Examiner's Answer. These two figures from the Examiner's Answer, as well as Murray's FIG. 2, have been reproduced below for use in explaining Applicant's position in this regard.



The Examiner has incorporated three bi-directional arrows in support of the contention that the body portion 13 of Bosco shown in FIG. 3 can be modified to include the adjustable means (17, 18, 20 and 21) of Murray shown in FIG. 1 to meet the limitations of the claimed invention. In support of this position, the Examiner has drawn a bi-directional arrow between pin 16 of Bosco and pin 16 of Murray and another bi-directional arrow between pin 17 of Bosco and an unnumbered pin connected to the upper end of a second jaw member 6 in Murray. The unnumbered pin pivotally connects link lever 19 and the second jaw member 6 as shown in attached FIG. 2 of Murray.

This unnumbered pin would not connect Bosco's body portion 13 to Murray's second jaw member 6, as alleged by the Examiner to meet the limitation recited in claim 1 of "adjustable means disposed in said body portion for coupling said clasp to said body portion" (emphasis added). The unnumbered pin in Murray relied upon by the examiner is connected to neither Murray's lever 15 (body), nor to its adjustable mechanism 17, 18, 20, 21 as shown in FIG. 3 of Murray. Rather, the unnumbered pin in Murray connects the link lever 19 to the second jaw member 6. Murray's link lever 19, which has no equivalent structure in the claimed invention, performs two important functions in the Murray clamp, neither of which involves drawing Murray's first and second jaw members 5 and 6 together as in the claimed invention. First, it includes a spring keeper or catch 22 which is adapted to engage the clamp's handle 15 for preventing displacement of handle 15 when the clamp is in the operative position as shown in FIG. 1. Secondly, when the lever 15 is moved from its position shown in FIG. 2 to the operative position shown in FIG. 1, link lever 19 urges the second jaw member 6 to parallel alignment with

the first jaw member 5 for maintaining the form walls 24 and 25 in fixed, parallel alignment. Moreover, incorporating this type of adjustable mechanism in Bosco would not draw the lugs 8 and 10 of Bosco together when Bosco's lever arm 13 is displaced about its claws 14 and 15 as recited in pending claims 1 and 21 further precluding the cited combination as forming the basis for a finding of *prima facie* obviousness.

The Examiner states that "Presumably, elements 7 and 6, 19 of Murray can be equated to elements 14 and 15 of Bosco." In Murray, jaw 6 is pivotally coupled to link lever 19 which connects jaw 6 to the adjustable mechanism. Clearly there is the combination of a link and a pivoting connection between Murray's jaw 6 and adjustable mechanism. To incorporate this pivoting linkage arrangement in Bosco, as suggested by the Examiner, would require that the Bosco claw 15 be comprised of first and second links coupled by a pivoting connection. The Examiner's contention that "the Murray clamp does not require the incorporation of a hinged coupling in Bosco's claw 15" is simply incorrect.

Because Murray's jaw part 6 and crosshead 7 are not drawn together when lever 15 is moved about these two components, as in the claimed invention, but are merely aligned parallel with one another is shown in Murray's FIG. 1, Murray requires a second adjustable mechanism. The second adjustable mechanism is comprised of plural spaced notches 10 located in a second elongated aperture 9 and a pin 11 all disposed within a shank 8. This second adjustable mechanism operates with the first adjustable mechanism in Murray's lever 15 to ensure that the spaced jaw part 6 and crosshead 7 are maintained in fixed, parallel, spaced alignment when the clamp is



applied to a pair of spaced walls 24 and 25 of a concrete form. The Examiner has not taken into account this portion of the adjustable mechanism of Murray in alleging that it would have been obvious to combine Murray with Bosco. As a result, the Examiner does not suggest where this latter adjustable mechanism of Murray would be incorporated in Bosco to arrive at the claimed invention.

From FIGS. 2 and 3 of Bosco, it can be seen that the Bosco handle 13 must be moved in a counterclockwise direction, as viewed in the figures, in order to move Bosco's claws 14 and 15 toward one another in drawing the interlocking members 4 and 5 together. However, in Murray the handle 15 is moved in a clockwise direction, as viewed in FIGS. 1 and 2, in order to maintain the first and second jaw members 6 and 7 in fixed, parallel, spaced relation. Thus, the adjustable mechanism in Murray could not be integrated in the handle 13 of Bosco to provide an adjustable feature. Moving Murray's handle 15 in a clockwise direction as viewed in the figures would not draw the pair of jaws 5 and 6 together because jaw 6 is connected to shank 8 by means of connecting pin 11 which would prevent Murray's jaws, and anything coupled to the jaws, from being drawn together as recited in pending claims 1 and 21. Moreover, upon counterclockwise rotation of Murray's handle 15 about pin 16, link lever 19 would engage pin 16 and prevent further displacement of the handle about pin 16 to render the adjustable mechanism in lever 15 unusable.

In citing Murray, the Examiner relies upon only those portions of Murray which allegedly support a finding of obviousness. The Examiner ignores other essential structures of Murray which are not found in the claimed invention and if incorporated in Bosco would render any such

combination inoperable. For example, Murray's adjustable feature incorporates a pair of elongated apertures each having spaced notches and movable pins, one incorporated in Murray's lever 15 and the other incorporated in shank 8. The Examiner does not discuss where the second adjustable mechanism in Murray's shank 8 would be incorporated in Bosco to arrive at the claimed invention. The Examiner also ignores the presence of shank 8 in Murray and the function that it performs in the clamp and also the presence of the link lever 19 in Murray. The examiner does not discuss how these additional structures could be incorporated in Bosco to arrive at the claimed invention. Applicant respectfully submits that the presence of link lever 19 in Murray or in Bosco would preclude the coupling of the clasp to the body portion in an operable manner as recited in claims 1 and 21.

It is improper to take bits and pieces of the prior art, selecting that which is favorable to a position, and ignoring that which is not. In this regard, the Federal Circuit has stated that:

Among legal standards for determining scope and context of the prior art, for example, are: a prior patent must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention.....

*Panduit Corp. v. Dennis Mfg. Co.*, 810 F.2d, 1 USPQ 2d 1592, 1597 1561 Fed. Cir. 1987. The Court went on to state that to base a finding of obviousness on the presence in separate prior art patents of individual elements differing greatly in shape, position, relation, combination, and function constitutes fundamental error. *Panduit*, 1 USPQ 2d at 1605. In the present case, the examiner has relied upon only those portions of Murray and Bosco which allegedly support a finding of obviousness while ignoring other essential elements of these devices which if

incorporated in the other reference would provide neither the claimed structure nor a workable apparatus as suggested by the examiner.

It is the examiner's position that the repair clamp recited in the claims is not part of the claimed invention and has not been given patentable weight because the recitation occurs in the claim preamble. The examiner has committed error in not considering the recitation of the repair clamp and various components of the repair clamp in the preamble as well as in the body of the claim as required for completely defining and understanding the apparatus recited in the balance of the claim. If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is "necessary to give life, meaning, and vitality" to the claim, then the claim preamble must be construed as if in the balance of the claim.

*Pitney Bowes Inc. v. Hewlett-Packard Co.*, 51 USPQ 2d 1161, 1165 (Fed. Cir. 1999).

Independent claims 1 and 21 recite that the claimed apparatus is intended for installing a repair clamp on a pipe and include specific components of the repair clamp with which the claimed apparatus is intended for use. For example, the body of each of claims 1 and 21 recites that the claimed "arm" includes a second end "adapted for insertion in an aperture in the first edge flange of the repair clamp." The claimed "clasp" is recited in the body of the claim as "adapted to engage an outer edge of the repair clamp's second edge flange." The body of the claim further recites that "pivoting displacement of said body portion about said arm and clasp to a second position draws the repair clamp's edge flanges together for securely maintaining the repair clamp on and in engagement with the pipe." Finally, the "adjustable means" is described as capable of

changing or adjusting “spacing between said arm and said clasp to accommodate a range of sizes of the repair clamp and diameters of the pipe.” Thus, in independent claims 1 and 21 the preamble is intimately meshed with the body of the claim, such that one without the other would provide an incomplete description of Applicant’s invention. In pending claims 1 and 21, the first appearance in the claim body of a recited structure can only be understood in the context of the preamble, wherein are recited structures of the pipe repair clamp with which elements of the claimed invention directly interface. Specific structures recited in the body of the claim are given meaning only if reference is made to the repair clamp and components thereof recited in the preamble. Thus, to hold that “the repair clamp is not part of the claimed invention” in the present case where structures recited in the claim body cannot be fully understood without reference to structures recited in the preamble is erroneous.

In summary, it is respectfully submitted that the invention recited in pending claims 1 - 3 and 11 - 40 should be found nonobvious and patentable over the combination of patents to Bosco and Murray because:

- neither Bosco (a flexible strap concrete form clamp) nor Murray (a device for maintaining the walls of a concrete mold in fixed, spaced position) discloses or suggests apparatus for installing a repair clamp on a pipe or an adjustable device for installing any type of clamp on anything;
- the pending claims recite structural limitations not found in the combination of Bosco and Murray, which structural limitations were nonobvious at the time of the invention over these references;

- the examiner has not shown how incorporating the three pivot pin adjustable mechanism of Murray would provide a workable adjustable feature in Bosco;
- the examiner has overlooked the preambles of claims 1 and 21 as necessary for completely defining and understanding the apparatus recited in the balance of these claims; and
- the examiner argues that only one half of the adjustable mechanism of Murray could be incorporated in Bosco, but does not discuss how or where the other half of Murray's adjustable mechanism would or could be incorporated in Bosco.

Respectfully submitted,

Date: 22 DEC. 2006

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